

### REMARKS

Applicants have carefully reviewed this Application in light of the Office Action mailed November 13, 2007. Claims 1, 3, 6, and 8-10 are pending in this Application. Claims 1, 3, 6, and 8-10 were rejected under 35 U.S.C. § 102(b) and 35 U.S.C. § 112, second paragraph. Claims 2, 4, 5, and 7 were previously cancelled without prejudice of disclaimer. Applicants have amended Claims 1 and 6 to correct formalities. Applicants respectfully request reconsideration and favorable action in this case.

#### Rejections under 35 U.S.C. § 112

Claims 1, 3, 6 and 8-10 were rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner alleges that the use of the phrase “tightly guided” renders Claims 1 and 6 indefinite. Applicants traverse this rejection. However, to reduce the time and expense required to obtain patent protection, Applicants have amended Claims 1 and 6 to overcome these rejections. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, and full allowance of Claims 1, 3, 6, and 8-10, as amended.

Applicants note that the phrase “tightly guided” was included within Applicants’ original claims as filed and was not rejected by the Examiner until the latest Office Action, which was Examiner’s *ninth* Office Action. Applicants are unaware of any change in applicable law, regulations, or the M.P.E.P. that would have made the use of such phrase allowable during the period of time ending upon Examiner’s issuance of the last Office Action, but now not allowable in the most recent Office Action. Applicants also note that during prosecution of the present Application, the Examiner has issued rejections under 35 U.S.C. § 112, second paragraph in a piecemeal fashion, which has frustrated Applicants’ efforts to obtain patent protection, and by any measure, is clearly an inefficient manner of examining Applications.

Applicants respectfully remind the Examiner that the M.P.E.P. requires examiners to issue *all* rejections in a single office action, so as to reduce the likelihood of piecemeal

prosecution. Accordingly, the Applicants respectfully request that if the Examiner has any further rejections under 35 U.S.C. § 112, second paragraph, that **all** such remaining rejections be issued in the next Office Action.

### **Rejections under 35 U.S.C. § 102**

Claims 1, 3, 6, and 8 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,899,389 issued to Arpad M. Pataki et al. ("Pataki"). Claims 6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,470,548 issued to Shoji Ushimura ("Ushimura"). Claims 6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,982,901 issued to Volker Holzgrefe ("901-Holzgrefe"). Claims 6 and 8-10 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,012,981 issued to Volker Holzgrefe et al. ("981-Holzgrefe"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

As an initial matter, Applicants reiterate by reference thereto their arguments and comments set forth in Applicants' Responses dated January 2, 2007 and September 20, 2007 ("Applicants' Previous Responses"), and supplement such arguments with the additional comments set forth below. Applicants' decision not to repeat any such arguments below is not a concession that any such arguments are incorrect, invalid, or without merit.

Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, for the reasons set forth in Applicants' Previous Response and the additional reasons set forth below.

### **Claims 1 and 3**

Independent Claim 1 recites, among other elements, a fuel injection valve that includes a nozzle needle with a nozzle needle seat that includes "the outer surface of the conical nozzle needle tip provided ***directly adjacent*** the frusto-conical body section of the

nozzle needle wherein the outer surfaces of a conical nozzle needle tip and of the frusto-conical body section of the nozzle needle each have an included angle, the included angle of the conical needle tip having an included angle essentially the same as the included angle of the frusto-conical body section of the nozzle needle.” Applicants have argued at length in the Previous Responses that none of the cited references teaches this element of Claim 1. In reply to the Applicants’ latest arguments regarding *Pataki*’s complete lack of any teaching as to this element, the Examiner dismissively states “Applicant’s argument regarding the recitation ‘directly adjacent’ has been addressed in the prior Office action.” (Office Action, Page 6). In the prior Office Action to which the Examiner refers, the Examiner states:

[A]pplicant’s cylindrical section 16 intervenes between conical nozzle top 10 and frusto-conical body section 24. Therefore, the term “directly adjacent” does not preclude intervening structures as used by applicant.

(Office Action of July 11, 2007, Page 5).

However, in their prior response, the Applicants completely refuted these arguments of the Examiner regarding the use of the term “directly adjacent,” yet the Examiner simply stands by his rejection without commenting or replying to the Applicants’ arguments.

To reiterate, Examiner’s assertion that “the term ‘directly adjacent’ does not preclude intervening structures as used by applicant” fails for numerous reasons. First, the dictionary definitions of “directly” and “adjacent” support Applicants’ arguments. Otherwise, the Examiner is effectively reading the phrase “directly adjacent,” and in particular the word “directly” out of Claim 1. Applicants submit with this response an Information Disclosure Statement including definitions of the words “directly” and “adjacent,” as defined by Merriam-Webster’s Online Dictionary (*see, e.g.* <http://www.m-w.com/dictionary/directly> and <http://www.m-w.com/dictionary/adjacent>). The word “directly” means, *inter alia*, “in immediate physical contact.” In addition, the word adjacent means, *inter alia*, “having a common endpoint or border <adjacent lots>” and “immediately preceding or following.” Accordingly, in the context of the present application, a plain reading of the term “directly adjacent” **does preclude** intervening structures. Thus, the Examiner’s assertion that “directly adjacent” does not preclude intervening structures is entirely without merit. If the

Examiner's construction of the term "directly adjacent" were to prevail, one could say that the state of Maine is "directly adjacent" to the state of California.

Second, Examiner's statement that "applicant's cylindrical section 16 intervenes between conical nozzle tip 10 and frusto-conical body section 24" completely ignores the embodiment set forth in Figure 4 of the Application, which depicts a nozzle needle tip 10 directly adjacent to frusto-conical body section 24, without any intervening elements.

As Applicants have previously noted, *Pataki*, on which Examiner relies for his rejection of Independent Claim 1, fails to disclose "a nozzle needle with a nozzle needle seat that includes "the outer surface of the conical nozzle needle tip provided ***directly adjacent*** the frusto-conical body section of the nozzle needle wherein the outer surfaces of a conical nozzle needle tip and of the frusto-conical body section of the nozzle needle each have an included angle, the included angle of the conical needle tip having an included angle essentially the same as the included angle of the frusto-conical body section of the nozzle needle." The structures of *Pataki* that the Examiner has equated to the "outer surface of the nozzle needle tip" and "frusto-conical section of the nozzle needle" are not directly adjacent in that there are one or more intervening elements.

Accordingly, for the reasons set forth above and in Applicants' Previous Responses, *Pataki* does not teach all of the elements of Claim 1 and, therefore, cannot anticipate Independent Claim 1 or Claim 3 that depends therefrom. Applicants request reconsideration, withdrawal of the rejection under 35 U.S.C. § 102(b) and full allowance of Claims 1 and 3.

#### Claims 6 and 8-10

Independent Claim 6 prior to amendment herein recited a fuel injection valve that includes a nozzle body including a nozzle body seat and a nozzle needle with a nozzle needle seat, with a gap formed between the nozzle needle and the nozzle body "such that the gap is operable to hydraulically dampen movement of the nozzle needle seat toward the nozzle body seat." As noted in Applicants' Previous Responses, the cited references do not disclose providing a gap designed for dampening of the motion between the nozzle body and the nozzle needle. In a prior Office Action, the Examiner responded:

Regarding applicant's argument that the prior art does not explicitly or inherently disclose that the gap is operable to hydraulically dampen the

movement of the nozzle needle, the recitation merely requires the ability to so perform and does not constitute a positively recited limitation. Even so, the pressure acting on the gap surface would inherently provide a dampening function.

(Office Action of July 11, 2007, Page 6).

Applicants' again strenuously object to Examiner's repeated attempts to ignore applicable patent law and reject the recited dampening function on grounds of inherency without providing any evidence of record to support the Examiner's contentions that the cited references have the ability to operate or perform in the manner claimed. Again, Applicants are simply asking that if the Examiner maintains the rejection, the Examiner provide some shred of evidence (*e.g.*, a prior art reference, an affidavit) that discloses that the gap disclosed in the cited references would so have the ability to operate or perform in the manner claimed. If it is indeed so evident to the Examiner that the gap disclosed in the cited references could so perform, it appears logical that the Examiner could find a reference or other evidence showing such ability to operate or perform.

Again, it is a well-settled principle of patent law that "[t]he fact that a certain result of characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112(IV), *citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Instead, to establish that a claim element is inherent in a prior art reference, *extrinsic* evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); M.P.E.P. § 2112(IV). Inherency, however, may not be established by probabilities or possibilities. *In re Robertson*, 169 F.3d at 745; M.P.E.P. § 2112(IV).

In spite of this bedrock principle of patent law, the Examiner has repeatedly maintained, despite any shred of evidence in any document of record in the present application, that the alleged gap present in each of the references has the ability to perform the dampening function. The Examiner has failed (despite the repeated protests of the Applicants) to provide proof (*e.g.*, references of record) to support the conclusion that the gaps purportedly disclosed in the cited references can perform the dampening function claimed by the Applicants. If the Examiner is relying upon personal knowledge, no affidavit

has been provided. *See* M.P.E.P § 2144.03 (setting forth the requirements of reliance of common knowledge in the art).

Accordingly, for the reasons set forth above and in Applicants' Previous Responses, the cited references do not disclose all of the elements of Independent Claim 6. Applicants respectfully request reconsideration, withdrawal of the rejections under 35 U.S.C. § 102(b) and full allowance of Claims 6 and Claims 8-10 that depend therefrom.

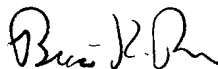
**CONCLUSION**

Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in condition for examination and allowance. For the foregoing reasons, Applicants respectfully requests reconsideration of the rejections and full allowance of Claims 1, 3, 6 and 8-10, as amended.

Applicants believe no fees are due, however the Commissioner is hereby authorized to charge any fees necessary to Deposit Account No. 50-2148 of Baker Botts L.L.P in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2684.

Respectfully submitted,  
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Date: Jan. 16, 2008

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